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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,328	11/13/2003	Stephan S. Porter	47168-00297USPT	9892
30223	7590	11/29/2006	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/713,328

Applicant(s)

PORTER ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/26/06.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Claims 36-40 stand withdrawn as being directed to a non-elected invention.

The Declaration filed on September 26, 2006 under 37 CFR 1.131 is sufficient to overcome the Kumar (2004/0038179) and Constantino (2003/0224327) references.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 13-24 and 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Kownacki et al (5302125). Kownacki shows an implant 12, Fig. 8, interior bore as shown, feedback feature 78, threaded section 26, abutment 20 for a prosthetic tooth, post 82, stem below 76, 79, feedback feature 46 and through bore as shown, abutment screw 22, head 86 and threads 30. Kownacki teaches that the fingers 40 can snap fit into position, column 3, lines 30-34 and column 4, lines 39-41. This snap fit inherently comprises a feedback feature. Noticing an inherent property of a known structure does not patentably distinguish over the structure. The snap fit taught by

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Klardie is inherently audible and tactile. As to claim 10, taper 48 on screw 22 inherently limits axial movement.

Claims 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumar et al (6394806). Kumar shows an implant 10, internal feedback feature 24, internal axial retention section 20 distal of the feedback feature 24. The shown structure is inherently capable of functioning as claimed. As to claim 12, see first internal anti-rotation feature 28, Fig. 2, and second anti-rotation feature 24 proximal to the first feature as shown.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al (6394806) in view of Brammann (5468150). Kumar shows the structure as described above, however, Kumar does not show an abutment. Brammann shows using an abutment 120. It would be obvious to one of ordinary skill in the art to modify Kumar to include an abutment as shown by 120 in order to mount a prosthesis.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kownacki et al (5302125) in view of Sutter (6227859). Kownacki teaches that the expanding fingers comprise an anti-rotation feature 42, column 3, lines 63-67, however Kownacki does not show a second anti-rotation feature. Sutter shows using expanding tongues 241 to additionally claim the abutment, column 11, lines 40-50, and teaches an embodiment, Fig. 11, showing a first anti-rotational 365, the area which the spreading tongues contact are proximal to first anti-rotational feature 365. It would be obvious to one of ordinary skill in the art to modify Kownacki to include a second anti-rotation feature 85, Fig. 5, 365, Fig. 11, as shown by Sutter in order to better hold a prosthesis in the proper position.

Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kownacki et al (5302125). Kownacki shows an implant 12, Fig. 8, interior bore as shown, feedback feature 78, threaded section 26, abutment 20 for a prosthetic tooth, post 82, stem below 76, 79, feedback feature 46 and through bore as shown, abutment screw 22, head 86 and threads 30. Klardie teaches that the fingers 40 can snap fit into position, column 3, lines 30-34 and column 4, lines 39-41. This snap fit inherently comprises a tactile feedback feature. Noticing an inherent property of a known structure does not patentably distinguish over the structure.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57, 67, 69 and 70 of copending Application No. 10/713,404 in view of Kownacki et al (5302125). The claims of the '404 application shows first and second anti-rotation features, however, do not show a feedback feature. Kownacki shows using a feedback feature 46, 78. It would be obvious to one of ordinary skill in the art to modify the '404 claims to include a feedback feature as shown by Kownacki in order to better seat an abutment.

This is a provisional obviousness-type double patenting rejection.

### ***Information Disclosure Statement***

The information disclosure statements filed September 26, 2006 has been considered and initialed and signed copies of each are attached.

***Response to Arguments***

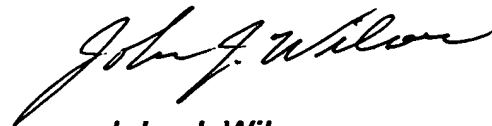
Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive. Applicant's remarks are held to be moot in view of the newly applied rejections above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
November 25, 2006